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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/528,018
Filing Date: May 12, 2005
Appellant(s): WARSTA ET AL.

Peter Flanagan (Reg. No.: 58,178)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 22 June 2009 appealing from the Office action mailed 16 October 2008 (including pre-appeal decision mailed 20 May 2009).

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on 17 November 2008 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon**A. Patent Documents**

2003/0092436	BOIVIN	5-2003
2004/0132449	KOWARSCH	7-2004
2003/0190913	COAD et al.	10-2003

(9) Grounds of Rejection Applicable to the Appealed Claims

The following ground(s) of rejection are applicable to the appealed claims:

A. Claim Rejections - 35 USC § 102

Claims 1-5, 10-13, 15, 19-25, 28-29, 32-36, and 39-41 are rejected under 35

U.S.C. 102(e) as being anticipated by **Boivin (US 2003/0092436 A1)**.

Regarding **claims 1, 19-22, and 32**, Boivin discloses a method (see Fig. 2), the method comprising:

receiving at a routing register a message associated with an inactive subscriber and including data relating to the identity of said subscriber of a communications network (see pg. 3, [0026]; Figs. 2-3), where the system is informed of a previously used telephone number;

based on the identity of said subscriber and on routing information stored at a register, selectively routing said message from said routing register to an inactive subscriber register for storing subscriber data for inactive subscribers (see pg. 2, [0018-0020]; pg. 3, [0025-0026]; Figs. 2-3), where the call is communicated via the MSC (208) to the PSP (202),

updating said routing information associated with the subscriber at the routing register to route subsequent signaling associated with the subscriber to an active subscriber register (see pg. 3, [0028, 0030]; pg. 2, [0018-0020]; Fig. 3 'ref. 312'), where the system updates the routing information for incoming and outgoing communication, which after the receipt of said message at the inactive subscriber register is provisioned with subscriber data required by the active subscriber register to service said subscriber (see pg. 3, [0028, 0030]; pg. 2, [0019-0020]; Fig. 3 'ref. 312'), where the system determines that the number is inactive and activates the telephone number.

Regarding **claims 2 and 24**, Boivin discloses the method as claimed in claim 1 further comprising:

storing a plurality of subscriber identities at the inactive subscriber register (see pg. 2, [0017-0018, 0020]); and

provisioning the active subscriber register with subscriber data if the data relating to the identity of the subscriber in the message corresponds to one of said plurality of subscriber identities (see pg. 3, [0030]; pg. 2, [0019-0020]), where the system updates the routing information for incoming and outgoing communication.

Regarding **claim 3**, Boivin discloses the method as claimed in claim 1, wherein the message is received from a mobile station of said inactive subscriber (see pg. 3, [0026]), where the system is informed of a previously used telephone number (see pg. 2, [0021, 0023]; Fig. 3).

Regarding **claims 4 and 25**, Boivin discloses the method as claimed in claim 3, wherein the message comprises international mobile subscriber identity (see pg. 2, [0017-0018]).

Regarding **claim 5**, Boivin discloses the method as claimed in claim 3, wherein the message further comprises data relating to the location of the mobile station (see pg. 2, [0019-0020]).

Regarding **claim 10**, Boivin discloses the method as claimed in claim 1, wherein the message is received from a visitor location register (see pg. 3, [0030]; pg. 2, [0017-0020]; Figs. 1-2), where the system updates the routing information for incoming and outgoing communication.

Regarding **claim 11**, Boivin discloses the method as claimed in claim 1, wherein the register comprises a service routing register (e.g., service control point 118) (see pg. 3, [0030]; pg. 2, [0019-0020]; Figs. 1-2).

Regarding **claim 12**, Boivin discloses the method as claimed in claim 1, wherein the inactive subscriber register comprises a provisioning home location register (e.g., server 218) (see pg. 3, [0030]; pg. 2, [0019-0020]; Figs. 1-2).

Regarding **claim 13**, Boivin discloses a method as claimed in claim 1, wherein the active subscriber register comprises a home location register (see pg. 2, [0017-0019]; Figs. 1-2).

Regarding **claims 15 and 28**, Boivin discloses the method as claimed in claim 1, wherein the inactive subscriber register also functions as one of: a voicemail system entity; a mail server entity; a multimedia messaging server entity; a wireless application

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part gateway entity; a prepaid server entity (e.g., prepaid server platform (PSP) 202); an intelligent network server; a short message service centre; location based service centre; a USSD-centre; a GPRS-server; a charging server; and rating server (see Fig. 2).

Regarding **claims 23 and 41**, Boivin discloses a method (see Fig. 2), the method comprising:

storing subscriber data for inactive subscribers of a communication network (see pg. 2, [0017-0020]; pg. 3, [0025-0026]; Figs. 2-3)

receiving at said inactive subscriber register a message identifying an inactive subscriber to be activated (see pg. 3, [0026]; Figs. 2-3), where the system is informed of a previously used telephone number;

provisioning an active subscriber register of the communication network with subscriber data associated with the inactive subscriber to be activated based on the received message (see pg. 3, [0030]; pg. 2, [0019-0020]), where the system updates the routing information for incoming and outgoing communication.

Regarding **claims 29 and 33-34**, the claim as applied to claim 20 are rejected for the same reasons as set forth above in **claims 4 and 12-13** respectively.

Regarding **claims 35-36**, the claims as applied to claim 23 are rejected for the same reasons as set forth above in **claims 2 and 4** respectively.

Regarding **claims 39-40**, the claims as applied to claim 23 are rejected for the same reasons as set forth above in **claims 12 and 28** respectively.

B. Claim Rejections - 35 USC § 103

Claims 6-8, 26-27, 30-31, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Boivin (US 2003/0092436 A1)** in view of **Kowarsch (US 2004/0132449 A1)**.

Regarding **claim 6**, Boivin discloses every limitation claimed as applied above in claim 3. Boivin does not specifically disclose having the feature(s) receiving from the inactive subscriber register data for providing the subscriber with a preliminary service. However, the examiner maintains that the feature(s) receiving from the inactive subscriber register data for providing the subscriber with a preliminary service was well known in the art, as taught by Kowarsch.

In the same field of endeavor, Kowarsch discloses the feature(s) receiving from the inactive subscriber register data for providing the subscriber with a preliminary service (see pg. 7, [0134]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Boivin and Kowarsch to have the feature(s) receiving from the inactive subscriber register data for providing the subscriber with a preliminary service, in order to permit a mobile station from a home network to operate in a visited network, as taught by Kowarsch (see pg. 3, [0019]).

Regarding **claim 7**, Boivin discloses every limitation claimed as applied above in claim 6. Boivin inexplicitly discloses having the feature(s) wherein said data receiving from the inactive subscriber register further comprises authentication information. However, the examiner maintains that the feature(s) wherein said data receiving from the

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inactive subscriber register further comprises authentication information was well known in the art, as taught by Kowarsch.

In the same field of endeavor, Kowarsch discloses the feature(s) wherein said data receiving from the inactive subscriber register further comprises authentication information (see pg. 8, [0139, 0152]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Boivin and Kowarsch to have the feature(s) wherein said data receiving from the inactive subscriber register further comprises authentication information, in order to permit a mobile station from a home network to operate in a visited network, as taught by Kowarsch (see pg. 3, [0019]).

Regarding **claim 8**, Boivin discloses every limitation claimed as applied above in claim 6. Boivin inexplicitly discloses having the feature(s) wherein said preliminary service comprises notifying the subscriber that a service request has been acknowledged. However, the examiner maintains that the feature(s) wherein said preliminary service comprises notifying the subscriber that a service request has been acknowledged was well known in the art, as taught by Kowarsch.

In the same field of endeavor, Kowarsch discloses the feature(s) wherein said preliminary service comprises notifying the subscriber that a service request has been acknowledged (see pg. 8, [0139, 0152]), where system provides communication for the MS (11) in which a notification message would be inherent since the user is able to utilize the system for communication.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Boivin and Kowarsch to have the feature(s) wherein said preliminary service comprises notifying the subscriber that a service request has been acknowledged, in order to permit a mobile station from a home network to operate in a visited network, as taught by Kowarsch (see pg. 3, [0019]).

Regarding **claims 26-27**, the claims as applied to claim 20 are rejected for the same reasons as set forth above in **claims 6-7** respectively.

Regarding **claims 30-31**, the claims as applied to claim 20 are rejected for the same reasons as set forth above in **claims 6-7** respectively.

Regarding **claims 37-38**, the claims as applied to claim 23 are rejected for the same reasons as set forth above in **claims 6-7** respectively.

Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Boivin (US 2003/0092436 A1)** in view of **Coad et al. (hereinafter Coad) (US 2003/0190913 A1)**.

Regarding **claim 17**, Boivin discloses a method as claimed in claim 1, comprising:

determining in said active subscriber register that the subscriber has again become inactive (see pg. 3, [0026]; Fig. 2), where the system is informed of a previously used telephone number;

storing subscriber data relating to the subscriber at the inactive subscriber register (see pg. 2, [0019-0020]; pg. 3, [0025-0026]; Fig. 2), where the call is communicated via the MSC (208) to the PSP (202);

updating the information stored at said routing register to specify said subscriber as inactive such that the routing register routes subsequent signaling associated with the subscriber to the inactive subscriber register (see pg. 3, [0028, 0030]; pg. 2, [0019-0020]; Figs. 2-3). Boivin does not specifically disclose having the feature(s) deleting subscriber data relating to the subscriber from the active subscriber register. However, the examiner maintains that the feature(s) deleting subscriber data relating to the subscriber from the active subscriber register was well known in the art, as taught by Coad.

In the same field of endeavor, Coad discloses the feature(s) deleting subscriber data relating to the subscriber from the active subscriber register (see pg. 2, [0036-0037]). As further support, Coad at the least further discloses determining in said active subscriber register that the subscriber has again become inactive (see pg. 1, [0026, 0009]); storing subscriber data relating to the subscriber at the inactive subscriber register (see pg. 1, [0028]); updating the information stored at said routing register to specify said subscriber as inactive such that the routing register routes subsequent signaling associated with the subscriber to the inactive subscriber register (see pg. 1, [0027-0028]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Boivin and Coad to have the feature(s) deleting subscriber data relating to the subscriber from the active subscriber register, in order to allow a user to use a mobile phone in a visited network, as taught by Coad (see pg. 1, [0005]).

Regarding **claim 18**, Boivin discloses every limitation claimed as applied above in claim 17. Boivin does not specifically disclose having the feature(s) determining that

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said a subscriber has become inactive if the time lapsed since a last message, associated with the subscriber, was routed exceeds a predetermined time. However, the examiner maintains that the feature(s) determining that said a subscriber has become inactive if the time lapsed since a last message, associated with the subscriber, was routed exceeds a predetermined time was well known in the art, as taught by Coad.

Coad further discloses determining that said a subscriber has become inactive if the time lapsed since a last message, associated with the subscriber, was routed exceeds a predetermined time (see pg. 2, [0035-0037]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Boivin and Coad to have the feature(s) determining that said a subscriber has become inactive if the time lapsed since a last message, associated with the subscriber, was routed exceeds a predetermined time, in order to allow a user to use a mobile phone in a visited network, as taught by Coad (see pg. 1, [0005]).

(10) Response to Argument

The Examiner's response to the arguments of the brief concerning the art rejection of claims 1-8, 10-13, 15, and 17-41 are as follows:

A. Brief Description of Registers with Subscriber Profile

The location information of a mobile station is maintained centrally by a home location register (**HLR**), wherein the mobile station is permanently registered as a **subscriber profile** at the home location register. At the same time the mobile station is

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registered locally by a visitor location register (**VLR**). A **VLR** is typically **implemented** in connection **with the MSC**...HLR may be a stand alone element in the network...the **HLR** may be integrated with another network element, such as **located within** one of the **switching centres**... (for above paragraph - see instant application, section background of the invention, pg. 2, 1st full par., lines 2-15)

Accordingly, although **subscriber profiles** are permanently registered at the HLR, a subscriber only needs to be registered on the HLR if the subscriber is active...space on HLRs is taken up by profiles for subscribers who are inactive... (for above paragraph - see instant application, section background of the invention, pg. 3, 1st full par.).

Subscriber information in a mobile communication system may also be **stored** in **a number of other elements** such as voice mail systems, short message service centers, **IN-servers**, multimedia messaging center (for above paragraph - see instant application, section background of the invention, pg. 3, 2nd full par.).

For example, subscriber profiles are created on the HLR form SIM (subscriber identity module) cards sold in the so called '**prepaid**' mobiles (for above paragraph - see instant application, section background of the invention, pg. 3, 3rd full par.).

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B1. Argument of Claims 1-5, 10-13, 15, 19-25, 28, 29, 32-36, and 39-41 (see brief - item VII, section A, pgs. 15-16)

Appellant argues - ...*Boivin...is not prior to the properly perfected priority date...should be disqualified as prior art...* (see pg. 15, 2nd full par.)

...*could only be considered prior art to the extent that it was included...is simply a one-page disclosure...* (see pg. 15, 2nd full par.)

B2. Response to argument of B1

Regarding appellant's arguments above (see B1), the Examiner respectfully disagrees. As a note, this appears to be appellant's first attempt to disqualify Boivin. Appellant appears to admit viewing of the Boivin provisional application. The priority date of Boivin provisional application **pre-dates** the priority date of the instant application. Furthermore, Boivin provides details to meet the requirement(s) of MPEP § 2136.03(III). For example, the Boivin provisional application provides language that describes at least **Figs. 2-3** in the Boivin non-provisional application as well as language to support the rejection of at least independent claims 1, 19, 20, 21, 22, 23, 32, and 41. Therefore, as addressed above, the Boivin reference is considered and maintained as prior art.

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C1. Argument of Claim 1 (see brief - item VII, section A-1, pgs. 18-19)

Appellant argues - *...fails to disclose...selectively routing said message from said routing register to an inactive subscriber register for storing subscriber data for inactive subscribers...* (see pg. 18, 1st full par.)

...fails to disclose...updating said routing information associated with the subscriber at the routing register to route subsequent signaling associated with the subscriber register is provisioned with subscriber data required by the active register to service said subscriber... (see pg. 19, 1st full par.)

C2. Response to argument of C1

Regarding appellant's arguments above (see C1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the prior art Boivin that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. In particular, Boivin discloses the argument(s) as related to the claimed feature(s)

based on the identity of said subscriber and on routing information stored at a register, selectively routing said message from said routing register to an inactive subscriber register for storing subscriber data for inactive subscribers (see pg. 2, [0018-0020]; pg. 3, [0025-0026]; Figs. 2-3), where the call is communicated via the MSC (208) to the prepaid server platform (PSP 202). For example, Boivin determines that a previous number is inactive in which a subscriber is a previous subscriber with data stored in the PSP (202 - includes prepaid service server 218, server database system 220, and IVR

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222) (see Fig. 3 'ref. 306, 310'), where the system determines if a user is a new user or returning user to assign a number (see pgs. 2-3, [0024-0025]). As commonly known in the art, a system has a storage of the inactivity status of a number so that when a phone user dials an inactive number the system typically provides a canned message such as you have dialed a number that is not in service or has temporarily been disconnected, checked the number you have dialed, or this number is not a working number.

updating said routing information associated with the subscriber at the routing register to route subsequent signaling associated with the subscriber to an active subscriber register (see pg. 3, [0028, 0030]; pg. 2, [0018-0020]; Fig. 3 'ref. 312'), where the system updates the routing information to transition the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 310, 312'),

which after the receipt of said message at the inactive subscriber register is provisioned with subscriber data required by the active subscriber register to service said subscriber (see pg. 3, [0028, 0030]; pg. 2, [0019-0020]; Fig. 3 'ref. 312'), where the system determines the status of the number and transitions the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 310, 312').

Therefore, as addressed above, the applied reference more than adequately meets the claim limitations.

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D1. Argument of Claim 19 (see brief - item VII, section A-2, pg. 21)

Appellant argues - ...*fails to disclose...route signaling associated with inactive subscribers to an inactive subscriber register...* (see pg. 21, 1st full par.)

...*fails to disclose...update said routing information for at least one of said inactive subscribers to route signaling to an active subscriber register when said at least one of said inactive subscribers becomes active...* (see pg. 21, 1st full par.)

D2. Response to argument of D1

Regarding appellant's arguments above (see D1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the prior art Boivin that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. In particular, Boivin discloses the argument(s) as related to the claimed feature(s)

route signaling associated with inactive subscribers to an inactive subscriber register (see pg. 2, [0018-0020]; pg. 3, [0025-0026]; Figs. 2-3), where the call is communicated via the MSC (208) to the PSP (202). For example, Boivin determines that a previous number is inactive in which a subscriber is a previous subscriber with data stored in the PSP (202 - includes prepaid service server 218, server database system 220, and IVR 222) (see Fig. 3 'ref. 306, 310'), where the system determines if a user is a new user or returning user to assign a number (see pgs. 2-3, [0024-0025]). As commonly known in the art, a system has a storage of the inactivity status of a number so that when a phone user dials an inactive number the system typically provides a canned message such as you

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have dialed a number that is not in service or has temporarily been disconnected, checked the number you have dialed, or this number is not a working number.

update said routing information for at least one of said inactive subscribers to route signaling to an active subscriber register when said at least one of said inactive subscribers becomes active (see pg. 3, [0028, 0030]; pg. 2, [0018-0020]; Fig. 3 'ref. 312'), where the system updates the routing information to transition the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 310, 312'),

a processor (e.g., 218/202) configured to provision the active subscriber register (see pg. 3, [0028, 0030]; pg. 2, [0019-0020]; Fig. 3 'ref. 312'), where the system determines the status of the number and transitions the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 310, 312'). Therefore, as addressed above, the applied reference more than adequately meets the claim limitations.

E1. Argument of Claim 21 (see brief - item VII, section A-3, pgs. 23-24)

Appellant argues - ... *fails to disclose...route signaling associated with inactive subscribers to an inactive subscriber register...* (see pg. 23, 2nd full par.)

... *fails to disclose...update said routing information for at least one of said inactive subscribers to route signaling to an active subscriber register when said at least one of said inactive subscribers becomes active...* (see pg. 24, 2nd full par.)

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E2. Response to argument of E1

Regarding appellant's arguments above (see E1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the prior art Boivin that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. In particular, Boivin discloses the argument(s) as related to the claimed feature(s)

route signaling associated with inactive subscribers to an inactive subscriber register (see pg. 2, [0018-0020]; pg. 3, [0025-0026]; Figs. 2-3), where the call is communicated via the MSC (208) to the PSP (202). For example, Boivin determines that a previous number is inactive in which a subscriber is a previous subscriber with data stored in the PSP (202 - includes prepaid service server 218, server database system 220, and IVR 222) (see Fig. 3 'ref. 306, 310'), where the system determines if a user is a new user or returning user to assign a number (see pgs. 2-3, [0024-0025]). As commonly known in the art, a system has a storage of the inactivity status of a number so that when a phone user dials an inactive number the system typically provides a canned message such as you have dialed a number that is not in service or has temporarily been disconnected, checked the number you have dialed, or this number is not a working number.

update said routing information for at least one of said inactive subscribers to route signaling to an active subscriber register when said at least one of said inactive subscribers becomes active (see pg. 3, [0028, 0030]; pg. 2, [0018-0020]; Fig. 3 'ref. 312'), where the system updates the routing information to transition the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref.

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310, 312’). Therefore, as addressed above, the applied reference more than adequately meets the claim limitations.

F1. Argument of Claim 21 (see brief - item VII, section A-3, pg. 25, 1st full par.)

Appellant argues - ...is not disclosed as provisioning an active subscriber register...

F2. Response to argument of F1

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (“provisioning an active subscriber register...””) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding appellant's argument in item F1, the appellant's argument relies on a feature(s) indicated above that is not recited in the claim(s).

G1. Argument of Claim 22 (see brief - item VII, section A-4, pgs. 26-28)

Appellant argues - ...*fails to disclose...selectively routing said message from said routing register to an active subscriber register for storing subscriber data for inactive subscribers...* (see pg. 26, 1st full par.)

...fails to disclose...updating said routing information associated with the subscriber at the routing register to route subsequent signaling associated with the subscriber to an active subscriber register, which after the receipt of said message at the inactive subscriber register is provisioned with subscriber data required by the active register to service said subscriber... (see par. bridging pgs. 27-28)

G2. Response to argument of G1

Regarding appellant's arguments above (see G1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the prior art Boivin that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. In particular, Boivin discloses the argument(s) as related to the claimed feature(s)

selectively routing said message from said routing register to an active subscriber register for storing subscriber data for inactive subscribers (see pg. 2, [0018-0020]; pg. 3, [0025-0026]; Figs. 2-3), where the call is communicated via the MSC (208) to the prepaid server platform (PSP 202). For example, Boivin determines that a previous number is inactive in which a subscriber is a previous subscriber with data stored in the PSP (202 - includes prepaid service server 218, server database system 220, and IVR 222) (see Fig. 3 'ref. 306, 310'), where the system determines if a user is a new user or returning user to assign a number (see pgs. 2-3, [0024-0025]). As commonly known in the art, a system has a storage of the inactivity status of a number so that when a phone user dials an inactive number the system typically provides a canned message such as you

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have dialed a number that is not in service or has temporarily been disconnected, checked the number you have dialed, or this number is not a working number.

updating said routing information associated with the subscriber at the routing register to route subsequent signaling associated with the subscriber to an active subscriber register (see pg. 3, [0028, 0030]; pg. 2, [0018-0020]; Fig. 3 'ref. 312'), where the system updates the routing information to transition the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 310, 312'),

which after the receipt of said message at the inactive subscriber register is provisioned with subscriber data required by the active subscriber register to service said subscriber (see pg. 3, [0028, 0030]; pg. 2, [0019-0020]; Fig. 3 'ref. 312'), where the system determines the status of the number and transitions the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 310, 312').

Therefore, as addressed above, the applied reference more than adequately meets the claim limitations.

H1. Argument of Claim 32 (see brief - item VII, section A-5, pg. 29)

Appellant argues - *...fails to disclose...route signaling associated with inactive subscribers to an inactive subscriber register...* (see pg. 29, 1st full par.)

...fails to disclose...update said routing information for at least one of said inactive subscribers to route signaling to an active subscriber register when said at least one of said inactive subscribers becomes active... (see pg. 30, 1st full par.)

H2. Response to argument of H1

Regarding appellant's arguments above (see H1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the prior art Boivin that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. In particular, Boivin discloses the argument(s) as related to the claimed feature(s)

route signaling associated with inactive subscribers to an inactive subscriber register (see pg. 2, [0018-0020]; pg. 3, [0025-0026]; Figs. 2-3), where the call is communicated via the MSC (208) to the PSP (202). For example, Boivin determines that a previous number is inactive in which a subscriber is a previous subscriber with data stored in the PSP (202 - includes prepaid service server 218, server database system 220, and IVR 222) (see Fig. 3 'ref. 306, 310'), where the system determines if a user is a new user or returning user to assign a number (see pgs. 2-3, [0024-0025]). As commonly known in the art, a system has a storage of the inactivity status of a number so that when a phone user dials an inactive number the system typically provides a canned message such as you have dialed a number that is not in service or has temporarily been disconnected, checked the number you have dialed, or this number is not a working number.

update said routing information for at least one of said inactive subscribers to route signaling to an active subscriber register when said at least one of said inactive subscribers becomes active (see pg. 3, [0028, 0030]; pg. 2, [0018-0020]; Fig. 3 'ref.

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312'), where the system updates the routing information to transition the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 310, 312'). Therefore, as addressed above, the applied reference more than adequately meets the claim limitations.

I1. Argument of Claim 32 (see brief - item VII, section A-5, par. bridging pgs. 30-31)

Appellant argues - ...is not disclosed as provisioning an active subscriber register...

I2. Response to argument of I1

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., see item I1 above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding appellant's argument in item I1, the appellant's argument relies on a feature(s) indicated above that is not recited in the claim(s).

J1. Argument of Claim 20 (see brief - item VII, section A-6, pg. 31, 1st full par.)

Appellant argues - ...*fails to disclose...a processor configured to provision an active subscriber register of the communication network with subscriber data associated with the inactive subscriber to be activated based on the received message...*

J2. Response to argument of J1

Regarding appellant's arguments above (see J1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the prior art Boivin that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. In particular, Boivin discloses the argument(s) as related to the claimed feature(s)

a processor (e.g., 218/202) configured to provision the active subscriber register of the communication network with subscriber data associated with the inactive subscriber to be activated based on the received message (see pg. 3, [0028, 0030]; pg. 2, [0019-0020]; Fig. 3 'ref. 312'), where the system determines the status of the number and transitions the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 306, 310, 312'). Therefore, as addressed above, the applied reference more than adequately meets the claim limitations.

K1. Argument of Claim 23 (see brief - item VII, section A-7, pg. 33, 1st full par.)

Appellant argues - *...fails to disclose...provisioning an active subscriber register of the communication network with subscriber data associated with the inactive subscriber to be activated based on the received message...*

K2. Response to argument of K1

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Regarding appellant's arguments above (see K1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the prior art Boivin that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. In particular, Boivin discloses the argument(s) as related to the claimed feature(s)

provisioning an active subscriber register of the communication network with subscriber data associated with the inactive subscriber to be activated based on the received message (see pg. 3, [0028, 0030]; pg. 2, [0019-0020]; Fig. 3 'ref. 312'), where the system includes sever (e.g., 218/202) that determines the status of the number and transitions the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 310, 312'). Therefore, as addressed above, the applied reference more than adequately meets the claim limitations.

L1. Argument of Claim 41 (see brief - item VII, section A-8, pg. 35, 1st full par.)

Appellant argues - *...fails to disclose...provisioning an active subscriber register of the communication network with subscriber data associated with the inactive subscriber to be activated based on the received message...*

L2. Response to argument of L1

Regarding appellant's arguments above (see L1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the prior art Boivin that clearly discloses the claimed feature(s) as would be clearly recognized by one

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of ordinary skill in the art. In particular, Boivin discloses the argument(s) as related to the claimed feature(s)

provisioning an active subscriber register of the communication network with subscriber data associated with the inactive subscriber to be activated based on the received message (see pg. 3, [0028, 0030]; pg. 2, [0019-0020]; Fig. 3 'ref. 312'), where the system includes sever (e.g., 218/202) that determines the status of the number and transitions the number from inactive to active to allow for incoming and outgoing communication (see Fig. 3 'ref. 310, 312'). For example, Boivin determines that a previous number is inactive in which a subscriber is a previous subscriber with data stored in the PSP (202 - includes prepaid service server 218, server database system 220, and IVR 222) (see Fig. 3 'ref. 306, 310'), where the system determines if a user is a new user or returning user to assign a number (see pgs. 2-3, [0024-0025]). As commonly known in the art, a system has a storage of the inactivity status of a number so that when a phone user dials an inactive number the system typically provides a canned message such as you have dialed a number that is not in service or has temporarily been disconnected, checked the number you have dialed, or this number is not a working number. Therefore, as addressed above, the applied reference more than adequately meets the claim limitations.

M1. Argument of Claims 2-5, 10-13, 15, 24-25, 28-29, 33-36, and 39-40 (see brief - item VII, section A-9 - A-27, pgs. 36-40)

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Appellant argues - ...*patentable for at least the reasons that claim 1...* (or a variation)

M2. Response to argument of M1

Regarding appellant's arguments above (see M1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the applied prior art Boivin that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. Consequently, all applied reference(s) were well known prior art prior to the filing of the instant application. Therefore, the claims are addressed for the same reasons as set forth above.

N1. Argument of Claims 6-8, 26-27, 30-31, and 37-38 (see brief - item VII, section B, pgs. 41-44)

Appellant argues - ...*fails to disclose...all the limitations...* (see pg. 41, 1st full par.)

...*fails to disclose...updating said routing information associated with the subscriber at the routing register to route subsequent signaling associated with the subscriber to an active subscriber register, which after the receipt of said message at the inactive subscriber register is provisioned with subscriber data required by the active subscriber register to service said subscriber...as recited in claim 1...* (see par. bridging pgs. 43-44)

N2. Response to argument of N1

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In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding appellant's arguments above (see N1), the Examiner respectfully disagrees. As a note, this is a **repetitious argument** addressed in *item C2* above.

Appellant has failed to interpret and appreciate the teachings of the applied prior art Boivin and Kowarsch that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. Consequently, all applied reference(s) were well known prior art prior to the filing of the instant application. Therefore, the claims are addressed for the same reasons as set forth above.

O1. Argument of Claims 6-8, 26-27, 30-31, and 37-38 (see brief - item VII, section B, pg. 42, 2nd full par.)

Appellant argues - ...*without hindsight reconstruction*...

O2. Response to argument of O1

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include

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knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding appellant's arguments above (see O1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the applied prior art Boivin and Kowarsch that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. Consequently, all applied reference(s) were well known prior art prior to the filing of the instant application. Therefore, the claims are addressed for the same reasons as set forth above.

P1. Argument of Claims 6-8, 26-27, 30-31, and 37-38 (see brief - item VII, section B-1 - B-9, pgs. 44-47)

Appellant argues - ...is not proper, because the alleged motivation...is not specific... (or a variation)

P2. Response to argument of P1

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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Regarding appellant's arguments above (see P1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the combined teachings of the applied prior art references Boivin and Kowarsch that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. Consequently, all applied references were well known prior art prior to the filing of the instant application. In this case, Kowarsch at the least discloses the feature(s) above to permit a mobile station from a home network to operate in a visited network, as taught by Kowarsch (see pg. 3, [0019]).

Q1. Argument of Claims 17-18 (see brief - item VII, section C, par. bridging pgs. 47-48)

Appellant argues - ...*Coad cannot be prior art...*

Q2. Response to argument of Q1

Regarding appellant's arguments above (see Q1), the Examiner respectfully disagrees. As a note, this appears to be appellant's first attempt to disqualify Coad. The priority date of Coad non-provisional application **pre-dates** the priority date of the instant application. Furthermore, Coad priority document meets the requirement(s) of MPEP § 706.02(f)(1)(I). Therefore, as addressed above, the Boivin reference is hereby maintained as prior art.

R1. Argument of Claims 17-18 (see brief - item VII, section C, pgs. 47-51)

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Appellant argues - ...*fails to disclose...all the limitations...* (see par. bridging pgs. 47-48)

...*fails to disclose...updating said routing information associated with the subscriber at the routing register to route subsequent signaling associated with the subscriber to an active subscriber register, which after the receipt of said message at the inactive subscriber register is provisioned with subscriber data required by the active subscriber register to service said subscriber...as recited in claim 1...* (see par. bridging pgs. 50-51)

R2. Response to argument of R1

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding appellant's arguments above (see R1), the Examiner respectfully disagrees. As a note, this is a **repetitious argument** addressed in *item C2* above.

Appellant has failed to interpret and appreciate the teachings of the applied prior art Boivin and Coad that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. Consequently, all applied reference(s) were well known prior art prior to the filing of the instant application. Therefore, the claims are addressed for the same reasons as set forth above.

S1. Argument of Claims 17-18 (see brief - item VII, section C, pg. 49, 1st full par.)

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Appellant argues - ...*without hindsight reconstruction*...

S2. Response to argument of S1

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding appellant's arguments above (see S1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the teachings of the applied prior art Boivin and Coad that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. Consequently, all applied reference(s) were well known prior art prior to the filing of the instant application. Therefore, the claims are addressed for the same reasons as set forth above.

T1. Argument of Claims 17-18 (see brief - item VII, section C-1 - C-2, pgs. 51-52)

Appellant argues - ...is not proper, because the alleged motivation...is not specific... (or a variation)

T2. Response to argument of T1

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Regarding appellant's arguments above (see T1), the Examiner respectfully disagrees. Appellant has failed to interpret and appreciate the combined teachings of the applied prior art references Boivin and Coad that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. Consequently, all applied references were well known prior art prior to the filing of the instant application. In this case, Coad at the least discloses the feature(s) above to allow a user to use a mobile phone in a visited network, as taught by Coad (see pg. 1, [0005]).

Furthermore, Coad at the least discloses a pre-paid account with an inactive status which is activated (see pg. 1, [0006-0007, 0028-0029]; pg. 2, [0033, 0035, 0041]).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/WJD,Jr/

Willie J. Daniel, Jr.
WJD,Jr

25 September 2009

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